



Docket No. 12969

UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler

O.K. to Enter

Group Art Unit: 1714

5 Serial No.: 09/398,377

P.S. 7/29/02

Examiner: Szekely, P.

Filing Date: 09/17/99

Title: Polymeric Thickeners for Oil-Containing Compositions

Box AF

10 Assistant Commissioner for Patents

Washington, DC 20231

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REPLY

15 Sir,

This paper is filed in reply to the Office Action mailed April 25, 2002, which is a final rejection. Applicant notes with appreciation the allowance (or allowability) of many of the claims. Reexamination, reconsideration and allowance of the rejected claims are respectfully requested in view of the Amendments and Remarks below.

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REQUEST TO RECONSIDER THE FINALITY OF THE OFFICE ACTION

and

CONDITIONAL PETITION TO THE COMMISSIONER

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If the Examiner does not agree that this application is now in condition for allowance, he is asked to reconsider and withdraw the finality of the Office Action. If the Examiner does not withdraw the finality of the Office Action, please treat this request as a Petition to the Commissioner to do so.

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231
On June 22, 2002

Typed name of person signing this certificate: T. H. P. Richardson

Signature

T. H. P. Richardson

Applicant submits that the finality of the Office Action should be withdrawn because the Office Action does not make it clear why certain claims have been rejected under 35 U.S.C. 102 and 103, and that as a result, no clear issue, suitable for consideration on appeal, has developed between the Examiner and the Applicant.

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Rejected claims 2, 7, 8, 10, 12-14 and 21-26 contain (directly or through their dependencies) a limitation that the side chain crystalline (SCC) polymer is "present in amount such that it thickens the oil". Applicant has argued (and continues to argue) that this limitation distinguishes these claims from the Mueller reference, in which an SCC polymer is added to a particular type of oil in an amount which makes the oil more pourable (i.e. thinner). Nevertheless, it is clear that the rejection of these claims under 35 U.S.C. 102/103 is based on the assumption that this limitation should be ignored. Thus, paragraph 11 of the Office Action, which sets out the rationale for the rejection of claims 2, 7-10 and 12-14 under 35 U.S.C. 102 and 103, does not answer the Applicant's arguments, fully set out in the previous Reply, that this limitation distinguishes the claims from Mueller, but rather states

Since the minimum amount of side chain crystalline polymer necessary to thicken the oil is not known, the limitation is meaningless. Furthermore the limitation is indefinite, not enabling and new matter."

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Since applicant is trying to cover the 1-3% range with their new limitation, the 3-10 % range limitation is meaningless.

The Examiner has also rejected these claims on the ground that there is no written description under 35 U.S.C. 112 for the limitation that the SCC polymer is "present in amount such that it thickens the oil". But the patentability of the claims under 35 U.S.C. 102/103 must be determined on the basis of the claims as they are written, not on the basis that the rejection under 35 U.S.C. 112 is correct.

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AMENDMENTS

Please amend this application as follows.